

## **REMARKS**

### **Background**

This Amendment is being filed concurrently with an Information Disclosure Statement (IDS). A Non-Final Office Action dated February 6, 2004 was issued in the above-identified application. Claims 1-31, 33-61 and 63-84 are pending in this application.

Claims 1, 11, 23, 36, 49, 63, 73 and 74 are currently amended by the present Amendment. Claims 1, 11, 23, 36, 49, 63, 73 and 74 are independent.

### **Rejection Under 35 USC § 102**

In the Office Action, claims 1, 2, 4-9, 11-12, 14, 16-21, 23, 30, 36-37, 39, 41-43, 45, 47-49, 56, 63-71, 73-75 and 77-83 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,954,798 to Shelton et al. ("Shelton").

Shelton is directed to a system for Internet synchronization that allows customers of a company to synchronize their browsers with customer service representatives ("agents") of the company. See Shelton Abstract and at col. 12, ln. 19 to col. 13 ln. 37. When a consumer visits a company's Web site, a session is created between the Web site and the consumer's browser. See Shelton at col. 9, lns. 47-49. The company Web site includes Web pages that are specifically enabled for synchronization. See Shelton at col. 7, lns. 1-5. Synchronization is facilitated via synchronization applets and, importantly, only enabled paged can be synchronized. See Shelton at col. 4 ln. 27 to col. 5 ln. 45. An enabled Web page is not independent from the synchronization applets since the enabled Web page includes targets to the synchronization applets. See Shelton at col. 7, lns. 1-5. In addition, the enabled Web page includes an individual Data Tracking and Synching (DTS) applet to monitor the user activities in each user input field

on an enabled Web page. See Shelton at col. 15, lns. 2-8. Therefore the number of DTS applets is directly related to the number of user input fields.

When the consumer wishes to synchronize their Web browsing with an agent, the consumer calls the company using a telephone and relays their session identifier to an agent. See Shelton at col. 12, lns. 24-29. Using additional applets, not available to the consumer, the agent enters the session identifier and initiates synchronization. See Shelton at col. 12, ln. 37 to col. 13 ln. 37. The consumer is not given access to the applets that can initiate Internet synchronization. See Shelton at col. 6, lns. 20-27. Since Web sites outside of the company are not enabled for synchronization, the Shelton Internet “synchronization [technique] is limited to pages served by a Web site that the [company] has control over.” See Shelton at col. 21, lns. 47-50. In addition, for security reasons, consumers have less access to certain synchronization applets than agents. See Shelton at col. 6, lns. 20-27. Shelton also describes a second agent or supervisor who can be added to the Web synchronization session. See Shelton at col. 17, lns. 22-26.

Applicant respectfully submits that, claim 1, as amended, is not anticipated under 35 U.S.C. §102(b) because Shelton does not disclose each and every element of claim 1, as amended, of the present application. See *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Claim 1, as amended, recites, *inter alia*, controlling Internet navigation of the second computer based upon Internet navigation of the first computer, wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. The Shelton technique uses synchronization applets instead of scripts and controls, as recited in claim 1, and the Shelton technique only works on enabled Web pages that are not

independent from the synchronization applets. See Shelton at col. 21, Ins. 47-50. For example, enabled Web pages are not independent from the synchronization applets because the enabled Web pages include tags for the synchronization applets and, the number of DTS applets is directly related to the number of user input fields on the Web page. See Shelton at col. 7, Ins. 1-5 and at col. 15, Ins. 2-8. Since the invention as recited in claim 1, as amended, describes a first script, a first control, a second script and a second control that are independent from the Web pages that are displayed on a first and second computer, and Shelton describes synchronization applets that are not independent from the Web pages displayed on a first and second computer, Shelton does not disclose all the features of claim 1, nor does Shelton render claim 1 obvious.

Applicant respectfully submits that Shelton does not teach or describe or suggest, as recited in claim 1, *inter alia*, controlling Internet navigation of the second computer based upon Internet navigation of the first computer, wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Shelton, on the other hand, describes synchronous Internet navigation limited to special enabled Web pages within a Web site controlled by the Internet synchronization service provider. See Shelton at col. 21, Ins. 47-50. Shelton's Internet navigation technique only works for enabled Web pages. In Shelton, the applets that facilitate synchronization are embedded into the Web pages as tags. See Shelton at col. 7, Ins. 1-5. In order for the Shelton technique to work with independent Web pages the applet tags would have to be appended to every Web page on the Internet. Second, Shelton describes using a separate DTS applet to monitor user changes in each user input field on a Web page. See Shelton at col.

15, Ins. 2-8. In other words if an enabled Web page has five user input fields, there would be five DTS applets to monitor changes in each of the fields. In short, the Shelton technique will not work with independent Web pages, that is typical Web pages not created in accordance with the special requirements of Shelton. Accordingly, applicant respectfully submits that Shelton does not disclose all the features of claim 1.

Independent claims 11, 23, 63, 73 and 74 of the present application, as amended, are allowable for similar reasons. For example, claims 11, 23, 63, 73, and 74, as amended, of the present application recite, *inter alia*, controlling Internet navigation of the second computer based upon Internet navigation of the first computer, wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Accordingly, applicant respectfully submits that claims 11, 23, 63, 73, and 74 are distinguishable from Shelton, at least for the reasons stated above with respect to the rejection of claim 1.

Independent claims 36 and 49, as amended, of the present application, are directed to systems with features similar to those of claims 1, 11, 23, 63, 73, and 74 . For example, claim 36 is directed to a system that includes a processor being further operable to enable the user of the first computer to synchronize with the user of the second computer, and control Internet navigation of the second computer based upon Internet navigation of the first computer, wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Claim 49 is directed to a system that includes a processor being further operable in connection with software to provide navigation functionality to control Internet navigation of the second computer based

upon Internet navigation of the first computer, wherein the first script and the first control and the second script and the second control are independent from Web pages that are displayed on the first computer and the second computer. Accordingly, applicant respectfully submits that claims 36 and 49 are distinguishable from Shelton, at least for the reasons stated above with respect to the rejection of claim 1.

Dependent claims 2, 4-9, 12, 14, 16-21, 30, 35-37, 39, 41-43, 45, 47, 48, 56, 62-71, 75 and 77-83 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49, 63, 73 and 74, as amended. Accordingly, applicant respectfully submits that claims 2, 4-9, 12, 14, 16-21, 30, 35-37, 39, 41-43, 45, 47, 48, 56, 62-71, 75 and 77-83 are distinguishable from Shelton, at least for the reasons stated above with respect to the rejection of claims 1, 11, 23, 36, 49, 63, 73 and 74.

Applicant respectfully submits that, Shelton does not disclose all of the features of claims 1, 2, 4-9, 11-12, 14, 16-21, 23, 30, 36-37, 39, 41-43, 45, 47-49, 56, 63-71, 73-75 and 77-83. Applicant further respectfully submits that as set forth above, the inventions recited by those claims are patentably distinguishable over Shelton, as Shelton fails to teach or suggest the above-discussed elements recited by those claims. See *id.* Accordingly, applicant respectfully requests withdrawal of the rejection of those claims. Applicant further respectfully submits that the inventions recited by those claims are not rendered obvious by any proposed hypothetical combination of Shelton and any other prior art of record or with the knowledge of a person of ordinary skill in the art. Specifically, there is no suggestion in the references to modify the systems of the references to include all features recited in the aforementioned claims. Early notification of allowance is respectfully requested.

**Rejection Under 35 USC § 103**

In the Office Action, claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Shelton and U.S. Patent Application Publication No. 2002/0083134 to Bauer, Jr. et al. ("Bauer").

The Examiner contends that while Shelton does not teach or suggest using instant messaging between parties, Bauer does. Bauer describes methods and apparatus for collaborative browsing that places Web users into cells. See Bauer at pg 1, para. 12. Different cells are formed based on similar Web sites. For example company A's Web sites may be grouped as one cell and a University's Web sites may be grouped as second cell. See Bauer at pg 3, para. 27. Placing Web users into these categorized cells unites Web users viewing similar Web pages. Similar to Shelton, Bauer's system is not independent from the Web pages, as Bauer's Web pages must be grouped into pre-identified cells.

As discussed above with respect to the rejections under 35 USC § 102, independent claims 1, 11, 23, 36, 49, 63 and 74, as amended, of the present application, claim, *inter alia*, a system or method comprising controlling the Internet navigation of a second computer based upon the Internet navigation of a first computer, wherein a first script and a first control and a second script and a second control are independent from Web pages that are displayed on a first computer and a second computer. Also, as discussed above, Shelton does not disclose all of the features of claims 1, 11, 23, 36, 49, 63 and 74, as amended. Dependent claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49, 63 and 74, as amended. Bauer does not teach or suggest the claimed features absent from Shelton as described above. Accordingly, applicant respectfully submit that the proposed

hypothetical combination of Shelton and Bauer, assuming arguendo such a combination were proper, does not disclose all of the features of claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 of the present application. See, e.g., *Texas Instruments v. United States ITC*, 988 F.2d 1165, 26 U.S.P.Q.2d 1018 (Fed. Cir. 1993). Therefore applicant respectfully traverses Examiner's contention that claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 are unpatentable over Shelton in view of Bauer.

Accordingly, applicant respectfully submits that a proposed hypothetical combination of Shelton and Bauer would not result in all of the features of claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84. In addition there is there no motivation, either explicit or implicit, to combine Shelton and Bauer. Therefore, applicant submits that claims 10, 22, 24, 34, 38, 44, 50, 58, 60, 72 and 84 are patentable over the proposed hypothetical combination of Shelton and Bauer and respectfully requests withdrawal of the rejection of those claims.

In the Office Action, claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76 were rejected under 35 U.S.C. §103(a) based on a hypothetical combination of Shelton and U.S. Patent Application Publication No. 2002/0035603 to Lee et al. ("Lee").

Lee describes methods and apparatus for collaborative browsing that includes a server that retrieves a Web page accessed by a first user, transforms the URL of the Web page, stores the Web page and then transmits the Web page to the first user. See Lee Abstract. The stored Web page is then transmitted to additional members of a collaborative browsing session. See Lee at pg 1, paragraph 10. Similar to Shelton, the Lee system is not independent of the Web pages as presently claimed.

As discussed above with respect to the rejections under 35 USC § 102, independent claims 1, 11, 23, 36, 49 and 74, as amended, of the present application, claim, *inter alia*, a system or method comprising controlling the Internet navigation of a second computer based upon the Internet navigation of a first computer, wherein a first script and a first control and a second script and a second control are independent from Web pages that are displayed on a first computer and a second computer. Also, as discussed above, Shelton does not disclose all of the features of claims 1, 11, 23, 36, 49 and 74, as amended. Dependent claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76 depend either directly or indirectly from one of claims 1, 11, 23, 36, 49 and 74, as amended. Lee does not teach or suggest the claimed features absent from Shelton as described above. Accordingly, applicant respectfully submits that the proposed hypothetical combination of Shelton and Lee does not disclose all of the features of claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76 of the present application. See, e.g., *Texas*, supra. Therefore applicant respectfully traverses with the Examiner's contention that claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76 are unpatentable over Shelton in view of Lee.

Accordingly, applicant respectfully submits that a proposed hypothetical combination of Shelton and Lee would not result in all of the features of claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76. Therefore, applicant submit that claims 3, 13, 15, 25-29, 31, 33, 35, 40, 46, 51-55, 57, 59, 61 and 76 are patentable over the proposed hypothetical combination of Shelton and Lee and respectfully requests withdrawal of the rejection of those claims.



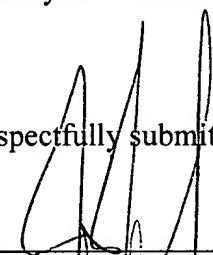
**Conclusion**

Applicant has considered the prior art of record, and respectfully submit that none of the references relied upon by the Examiner in rejecting the claims of the present application, considered alone or in any hypothetical combination (between and among each other or with the knowledge of a person of ordinary skill in the art), teach or suggest applicant's invention, as recited by the claims of the present application.

Applicant respectfully request reconsideration of the present application in view of the amendments to the claims and in view of the remarks provided herein. If the Examiner is not in a position to allow all claims as presently amended, the Examiner is urged to call the undersigned attorney at 212-806-5400. Any additional fees or charges required at this time or in the future in connection with the present application are hereby authorized to be charged to Deposit Account No. 19-4709.

Respectfully submitted,

By



James J. DeCarlo  
Registration No. 36,120  
Attorney For Applicant  
Stroock & Stroock & Lavan LLP  
180 Maiden Lane  
New York, New York 10038-4982  
(212) 806-5400